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Supreme Court of the United States

OCTOBER TERM, 1928.

NO. 372

THE UNITED STATES PRINTING & LITHOGRAPHING COMPANY,
Petitioner,

vs.

GRIGGS COOPER & COMPANY,
Respondent.

BRIEF OF GRIGGS COOPER & COMPANY, RESPONDENT, IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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MAY IT PLEASE THIS COURT:

Griggs Cooper & Company, a corporation, Respondent, respectfully presents to this Honorable Court this brief in opposition to the granting of the Writ of Certiorari, as prayed for by Petitioner, on the following grounds:

I.

The Petitioner neglects to quote to this Honorable Court the section 16 of the Trade Mark Act of 1905, upon which the decision of the Court below was founded. This section reads as follows:

"UNITED STATES TRADE MARK ACT OF 1905.

"SEC. 16. That the registration of a trade mark under the provisions of this act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs."

We respectfully submit:

(a) The above section gives to Griggs Cooper & Company, Respondent, protection all over the United States in interstate commerce, regardless of the extension of trade.

(b) The Act of 1905 places trade marks and patents on a similar basis regarding monopoly.

(c) Congress has power, under the constitution, to create trade mark rights, and as held by the Supreme Court of Ohio does hold that section not unconstitutional.

II.

The trade mark cases referred to by Petitioner (p. 6) have no bearing on the question before this Honorable Court, as is evidenced by the concluding words of the opinion:

> "In what we have here said, we wish to be understood as leaving the whole question of the treaty making power of the general government and the duty of Congress, to pass any laws necessary to carry such treaties into effect, *untouched*."
>
> 100 U. S. 82, 25 L. Ed. 550.

III.

The case of

> Hanover Star Milling v. Metcalf, 240 U. S. 402, 60 L. Ed. 713

(cited by counsel p. 5), has nothing to do with the question before this Honorable Court, for it was decided according to common law principles of general application, none of the parties having registered the trade mark in question in that case under any act of Congress or under the laws of any state.

IV.

The same remarks apply to the Rectanus Co. case, (cited by counsel p. 6):

> United Drug Co. v. Rectanus Co., 248 U. S. 90, 63 L. Ed. 141, 39 Sup. Ct. R. 48.

This Honorable Court in this case was considering the question from the standard of the common law and the Act of 1881

(Chap. 138, 21 Stat. L. 502). This act was superseded by the Act of Feb. 20, 1905.

9 Fed. Stats. Ann. 748,

and held squarely that Sec. 16 of the Act of 1905 was not in the case in the following language:

> "The Act of Feb. 20, 1905, which took the place of the Act of 1881 while extending protection to trade marks used in interstate commerce, does not enlarge the effect of previous registrations unless renewed under the provisions of the twelfth section, which was not done in this case, hence we need not consider whether anything in this case would aid the petitioner's case."

It was further said in this case that a trade mark confers no monopoly whatever in a proper sence, but merely a mark or symbol and then used this important language on page 51 Sup. Ct. Reports:

> "It results that the adoption of a trade mark does not, at least in the absence of some valid legislation for the purpose, project the right of protection in the advance of the extension of trade or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade."

And it is conceded by the Petitioner that this court did not have before it a situation involving the registration of a trade mark under the Act of 1905 (Record p. 13).

We respectfully submit that the act in question was passed to clarify the situation relating to trade marks and give trade marks their proper place in the "commerce" of the nation, and is the "valid legislation" referred to in the above quotation.

V.

The record in the present case does not present the question as to the rights of local users as described in the Hanover Milling Co. case and the Rectanus case, because the statute gives Griggs Cooper & Company, the *prima facie* right, and the Petitioner failed to prove that there were any local users who had commenced their business and built up their trade prior to the registration of the trade marks of Griggs Cooper & Co., and the burden was on the Petitioner to prove such an exception to our prima facie case.

VI.

The provisions of the Act do not violate the Constitution, but are authorized by Section 8, Article 1 wherein power is conferred upon Congress "to regulate commerce with foreign nations and among the several states and with the Indian tribes" (Rec. p. 16).

And the rights of local users are subject to the paramount authority vested in Congress by the Constitution.

VII.

Such results are no more drastic or extensive than in the case of

Louisville & Nashville R. Co. v. Mottley, 219 U. S. 467

and we respectfully refer to the case of

U. S. v. Ferger, 250 U. S. 199, 55 L. Ed. 297

where this Court said (page 302 L. Ed.):

> "The provision in the constitution does not, as we believe, exclude congress from legislating with regard to contracts of the above nature, *while in the exercise of its constitutional right to regulate commerce among the several states*,—(the italics are the court's), and further,—

"anything which directly obstructs and thus regulates the commerce which is carried on among the states whether it is state legislation or private contracts between individuals or corporations, ***should be subject to the power of congress in the regulation of that commerce.***" (The italics are ours.)

And we respectfully refer to the remarks of His Honor Chief Justice Taft, in a case involving the construction of Section 9 of the Act of 1905:

American Steel Foundries v. Robertson, 262 U. S. 209,

"It is obvious from that section and the whole of the Trade Mark Act, that Congress intended to produce a parallelism in the mode of securing these two kinds of Government monopoly from the patent office" (Rec. p. 16).

The rule long applied relative to infringers of patents is alike applicable in the case at bar, and to quote from the decision appealed from:

"That is that all who actively and intentionally aid and abet the infringing are equally infringers,"—citing cases (Rec. p. 17).

The opinion of Mr. Justice Matthias is respectfully referred to (Rec. p. 7).

We submit that the petition for a Writ of Certiorari be denied.

Respectfully,

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Counsel for Respondent.